

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

was "abandoned for failure to perfect the drawings" (see copy of e-mail from PUBS Customer Service attached as Exhibit D). In telephone conferences with the Office of Petitions and PUBS Customer Service at the PTO on July 15, 2003, applicant's representative was notified that the basis for the Notice of Abandonment was failure to timely pay the issue fee, and not failure to perfect the drawings. A Notice of Abandonment was not received by the applicant until July 16, 2003, at which time a copy of the Notice of Abandonment was faxed to applicant's representative as requested in a July 15, 2003, telephone conference with E. Shirene Willis of the PTO (copy attached as Exhibit E). In particular, the undersigned asserts that a search of the file jacket and docket records indicates that the Notice of Abandonment was not received. A copy of the docketing record for the above-identified application showing the last action entered (the completed date for the Issue Fee and Formal Drawings filed on January 7, 2003 in response to the Notice of Allowance mailed October 7, 2002) is attached hereto as Exhibit F. A copy of the front of the file for the above-identified application showing the last action entered (the issue fee with formal drawings filed on January 7, 2003) is attached hereto as Exhibit G.


Pursuant to 37 C.F.R. § 1.181(a) and Manual of Patent Examining Procedure (MPEP) § 711.03(c) and in view of all the foregoing, applicants hereby petition the Commissioner for Patents to withdraw the holding of abandonment and allow the above-identified application to go to issue.

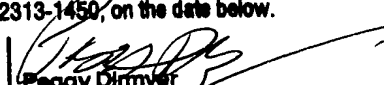
Although applicants believe that no fee is due upon consideration of this Petition, the Commissioner is authorized to charge any necessary fees, including any deficiency between the issue fee previously paid and the current amount for the issue fee due, to Deposit Account No. 14-1138.

Respectfully submitted,

Date: July 24, 2003

Nixon Peabody LLP  
Clinton Square, P.O. Box 31051  
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Telephone: (585) 263-1672  
Facsimile: (585) 263-1600

  
Georgia Evans  
Registration No. 44,597

| Certificate of Mailing - 37 CFR 1.8(a)  |  |
|---|--|
| I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:<br>Commissioner for Patents, P.O. Box 1460<br>Alexandria, VA 22313-1460, on the date below. |  |
| Date<br><u>7/24/03</u>  | <br>Peggy Dirmeyer |

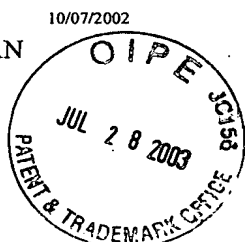


## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
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## NOTICE OF ALLOWANCE AND FEE(S) DUE

7590  
MICHAEL L GOLDMAN  
NIXON PEABODY LLP  
CLINTON SQUARE  
P O BOX 1051  
ROCHESTER, NY 14603



NOV 1 2002  
19603/1021596  
Issue Fee / Formal  
DRAWINGS DUE:  
January 7, 2003

|                   |                |
|-------------------|----------------|
| EXAMINER          |                |
| HUTSON, RICHARD G |                |
| ART UNIT          | CLASS-SUBCLASS |
| 1652              | 435-194000     |

DATE MAILED: 10/07/2002

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 08/828,323      | 03/28/1997  | MICHAEL E. O'DONNELL | 19603/10213         | 4760             |

TITLE OF INVENTION: DNA POLYMERASE III HOLOENZYME

| APPLN. TYPE    | SMALL ENTITY | ISSUE FEE | PUBLICATION FEE | TOTAL FEE(S) DUE | DATE DUE   |
|----------------|--------------|-----------|-----------------|------------------|------------|
| nonprovisional | NO           | \$1280    | \$0             | \$1280           | 01/07/2003 |

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. PROSECUTION ON THE MERITS IS CLOSED. THIS NOTICE OF ALLOWANCE IS NOT A GRANT OF PATENT RIGHTS. THIS APPLICATION IS SUBJECT TO WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE OFFICE OR UPON PETITION BY THE APPLICANT. SEE 37 CFR 1.313 AND MPEP 1308.

THE ISSUE FEE AND PUBLICATION FEE (IF REQUIRED) MUST BE PAID WITHIN THREE MONTHS FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. THIS STATUTORY PERIOD CANNOT BE EXTENDED. SEE 35 U.S.C. 151. THE ISSUE FEE DUE INDICATED ABOVE REFLECTS A CREDIT FOR ANY PREVIOUSLY PAID ISSUE FEE APPLIED IN THIS APPLICATION. THE PTOL-85B (OR AN EQUIVALENT) MUST BE RETURNED WITHIN THIS PERIOD EVEN IF NO FEE IS DUE OR THE APPLICATION WILL BE REGARDED AS ABANDONED.

## HOW TO REPLY TO THIS NOTICE:

## I. Review the SMALL ENTITY status shown above.

If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:

- A. If the status is the same, pay the TOTAL FEE(S) DUE shown above.
- B. If the status is changed, pay the PUBLICATION FEE (if required) and twice the amount of the ISSUE FEE shown above and notify the United States Patent and Trademark Office of the change in status, or

If the SMALL ENTITY is shown as NO:

- A. Pay TOTAL FEE(S) DUE shown above, or
- B. If applicant claimed SMALL ENTITY status before, or is now claiming SMALL ENTITY status, check the box below and enclose the PUBLICATION FEE and 1/2 the ISSUE FEE shown above.

☐ Applicant claims SMALL ENTITY status.  
See 37 CFR 1.27.

II. PART B - FEE(S) TRANSMITTAL should be completed and returned to the United States Patent and Trademark Office (USPTO) with your ISSUE FEE and PUBLICATION FEE (if required). Even if the fee(s) have already been paid, Part B - Fee(s) Transmittal should be completed and returned. If you are charging the fee(s) to your deposit account, section "4b" of Part B - Fee(s) Transmittal should be completed and an extra copy of the form should be submitted.

III. All communications regarding this application must give the application number. Please direct all communications prior to issuance to Box ISSUE FEE unless advised to the contrary.

**IMPORTANT REMINDER:** Utility patents issuing on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.

# Notice of Allowability

Application No.

09/828,323

Examiner

Richard G Hutson

Applicant(s)

RICHARDSON ET AL.

Art Unit

1652

## -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☐ This communication is responsive to paper filed on 6/25/2002.
2. ☒ The allowed claim(s) is/are 5, 7, 8, 10, 12-14, 16, 17, 54, 55, 58-60, 62, 64 and 65, 76 & 77.
3. ☐ The drawings filed on \_\_\_\_\_ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All    b) ☐ Some\*    c) ☐ None    of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- \* Certified copies not received: \_\_\_\_\_.
5. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - (a) ☐ The translation of the foreign language provisional application has been received.
6. ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application. **THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

7. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
8. ☒ CORRECTED DRAWINGS must be submitted.
  - (a) ☒ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
    - 1) ☐ hereto or 2) ☒ to Paper No. 4.
  - (b) ☐ including changes required by the proposed drawing correction filed \_\_\_\_\_, which has been approved by the Examiner.
  - (c) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No. \_\_\_\_\_.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the top margin (not the back) of each sheet. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

9. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

## Attachment(s)

- |   |  |
|---|--|
| 1 <input type="checkbox"/> Notice of References Cited (PTO-892)   | 2 <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3 <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | 4 <input type="checkbox"/> Interview Summary (PTO-413), Paper No. _____    |
| 5 <input checked="" type="checkbox"/> Information Disclosure Statements (PTO-1449), Paper No. <u>31, 36</u> | 6 <input checked="" type="checkbox"/> Examiner's Amendment/Comment         |
| 7 <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit of Biological Material      | 8 <input type="checkbox"/> Examiner's Statement of Reasons for Allowance   |
|   | 9 <input type="checkbox"/> Other   |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 6/25/2002 has been entered.

### ***Information Disclosure Statement***

The information disclosure statements (IDS) submitted on 6/25/2002 and 7/18/2002 have been considered by the examiner.

## **EXAMINER'S AMENDMENT**

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Georgia Evans on 10/3/2002.

Art Unit: 1652

The application has been amended as follows:

Replace with the following claims:

5. An isolated DNA molecule encoding a protein  $\delta'$  subunit of polymerase III holoenzyme, wherein a polymerase III holoenzyme comprising the subunit is capable of stimulating DNA synthesis, wherein the DNA molecule comprises a nucleic acid sequence which hybridizes to a nucleotide sequence corresponding to SEQ ID NO. 13 when hybridization is performed in 2X SSC, 0.2% SDS at 53°C.

14. An isolated protein  $\delta'$  subunit of polymerase III holoenzyme, wherein a polymerase III holoenzyme comprising the subunit is capable of stimulating DNA synthesis, wherein the protein subunit is encoded by a DNA molecule comprising a nucleic acid sequence which hybridizes to a nucleotide sequence corresponding to SEQ ID NO. 13, when hybridization is performed in 2X SSC, 0.2% SDS at 53°C.

Please add the following new claims:

76. An isolated DNA molecule consisting of SEQ ID NO. 11 or SEQ ID NO. 12.

77. An isolated protein consisting of the amino acid sequence encoded by SEQ ID NO. 11 or SEQ ID NO. 12.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard G Hutson whose telephone number is (703) 308-0066. The examiner can normally be reached on 7:30 am to 4:00 pm, M-F.

Art Unit: 1652

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on (703) 308-3804. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3014 for regular communications and (703) 305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Richard Hutson, Ph.D.  
Patent Examiner  
Art Unit 1652  
October 3, 2002

  
REBECCA E. PROUTY  
PRIMARY EXAMINER  
GROUP 1800  
1600

## PART B - FEE(S) TRANSMITTAL

Complete and send this form, together with applicable fee(s), to: **Mail** Box ISSUE FEE  
**Commissioner for Patents**  
**Washington, D.C. 20231**  
**Fax** (703)746-4000

INSTRUCTIONS: This form should be used for transmitting the ISSUE FEE and PUBLICATION FEE (if required). Blocks 1 through 4 should be completed where appropriate. All further correspondence including the Patent, advance orders and notification of maintenance fees will be mailed to the current correspondence address as indicated unless corrected below or directed otherwise in Block 1, by (a) specifying a new correspondence address; and/or (b) indicating a separate "FEE ADDRESS" for maintenance fee notifications.

CURRENT CORRESPONDENCE ADDRESS (Note: Legibly mark-up with any corrections or use Block 1)

7590

10/07/2002

MICHAEL L GOLDMAN  
 NIXON PEABODY LLP  
 CLINTON SQUARE  
 P O BOX ~~4051~~ 31051  
 ROCHESTER, NY 14603 - 1051



Note: A certificate of mailing can only be used for domestic mailings of the Fee(s) Transmittal. This certificate cannot be used for any other accompanying papers. Each additional paper, such as an assignment or formal drawing, must have its own certificate of mailing or transmission.

## Certificate of Mailing or Transmission

I hereby certify that this Fee(s) Transmittal is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to the Box Issue Fee address above, or being facsimile transmitted to the USPTO, on the date indicated below.

Janice Bowers

(Depositor's name)

Janice Bowers

(Signature)

January 7, 2003

(Date)

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 08/828,323      | 03/28/1997  | MICHAEL E. O'DONNELL | 19603/10215         | 4760             |

TITLE OF INVENTION: DNA POLYMERASE III HOLOENZYME

| APPLN. TYPE    | SMALL ENTITY | ISSUE FEE | PUBLICATION FEE | TOTAL FEE(S) DUE | DATE DUE   |
|----------------|--------------|-----------|-----------------|------------------|------------|
| nonprovisional | NO           | \$1280    | \$0             | \$1280           | 01/07/2003 |

| EXAMINER          | ART UNIT | CLASS-SUBCLASS |
|-------------------|----------|----------------|
| HUTSON, RICHARD G | 1652     | 435-194000     |

1. Change of correspondence address or indication of "Fee Address" (37 CFR 1.363).

☐ Change of correspondence address (or Change of Correspondence Address form PTO/SB/122) attached.

☐ "Fee Address" indication (or "Fee Address" Indication form PTO/SB/47; Rev 03-02 or more recent) attached. Use of a Customer Number is required.

2. For printing on the patent front page, list (1) the names of up to 3 registered patent attorneys or agents OR, alternatively, (2) the name of a single firm (having as a member a registered attorney or agent) and the names of up to 2 registered patent attorneys or agents. If no name is listed, no name will be printed.

1 Nixon Peabody LLP

2 \_\_\_\_\_

3 \_\_\_\_\_

## 3. ASSIGNEE NAME AND RESIDENCE DATA TO BE PRINTED ON THE PATENT (print or type)

PLEASE NOTE: Unless an assignee is identified below, no assignee data will appear on the patent. Inclusion of assignee data is only appropriate when an assignment has been previously submitted to the USPTO or is being submitted under separate cover. Completion of this form is NOT a substitute for filing an assignment.

(A) NAME OF ASSIGNEE

(B) RESIDENCE: (CITY and STATE OR COUNTRY)

Cornell Research Foundation, Inc.

Ithaca, New York 14850

Please check the appropriate assignee category or categories (will not be printed on the patent)

☐ individual ☒ corporation or other private group entity ☐ government

4a. The following fee(s) are enclosed:

☒ Issue Fee

☐ Publication Fee

☒ Advance Order - # of Copies 10

4b. Payment of Fee(s):

☐ A check in the amount of the fee(s) is enclosed.

☐ Payment by credit card. Form PTO-2038 is attached.

☐ The Commissioner is hereby charged the required fee(s), or credit any overpayment, to Deposit Account Number \_\_\_\_\_ (enclose an extra copy of this form).

Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) as to re-apply any previously paid issue fee to the application identified above.

(Authorized Signature) \_\_\_\_\_ (Date) 1/7/03

NOTE: The Issue Fee and Publication Fee (if required) will not be accepted from anyone other than the applicant; a registered attorney or agent; or the assignee or other party in interest as shown by the records of the United States Patent and Trademark Office.

This collection of information is required by 37 CFR 1.311. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, Washington, D.C. 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, Washington, DC 20231.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMIT THIS FORM WITH FEE(S)



PATENT  
Docket No.: 19603/10215 (CRF D-1156D)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant : Michael E. O'Donnell  
Serial No. : 08/828,323  
Cnfrm. No. : 4760  
Filed : March 28, 1997  
For : DNA POLYMERASE III  
HOLOENZYME

Examiner:  
R. Hutson

Art Unit:  
1652

**SUBMISSION OF CORRECTED FORMAL DRAWINGS**

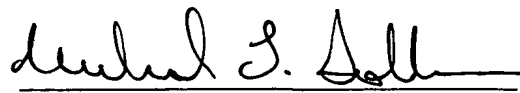
U.S. Patent and Trademark Office  
P.O. Box 2327  
Arlington, VA 22202  
**Box: Issue Fee**

Dear Sir:

Enclosed for filing in the subject application are thirteen (13) sheets of corrected formal drawings.

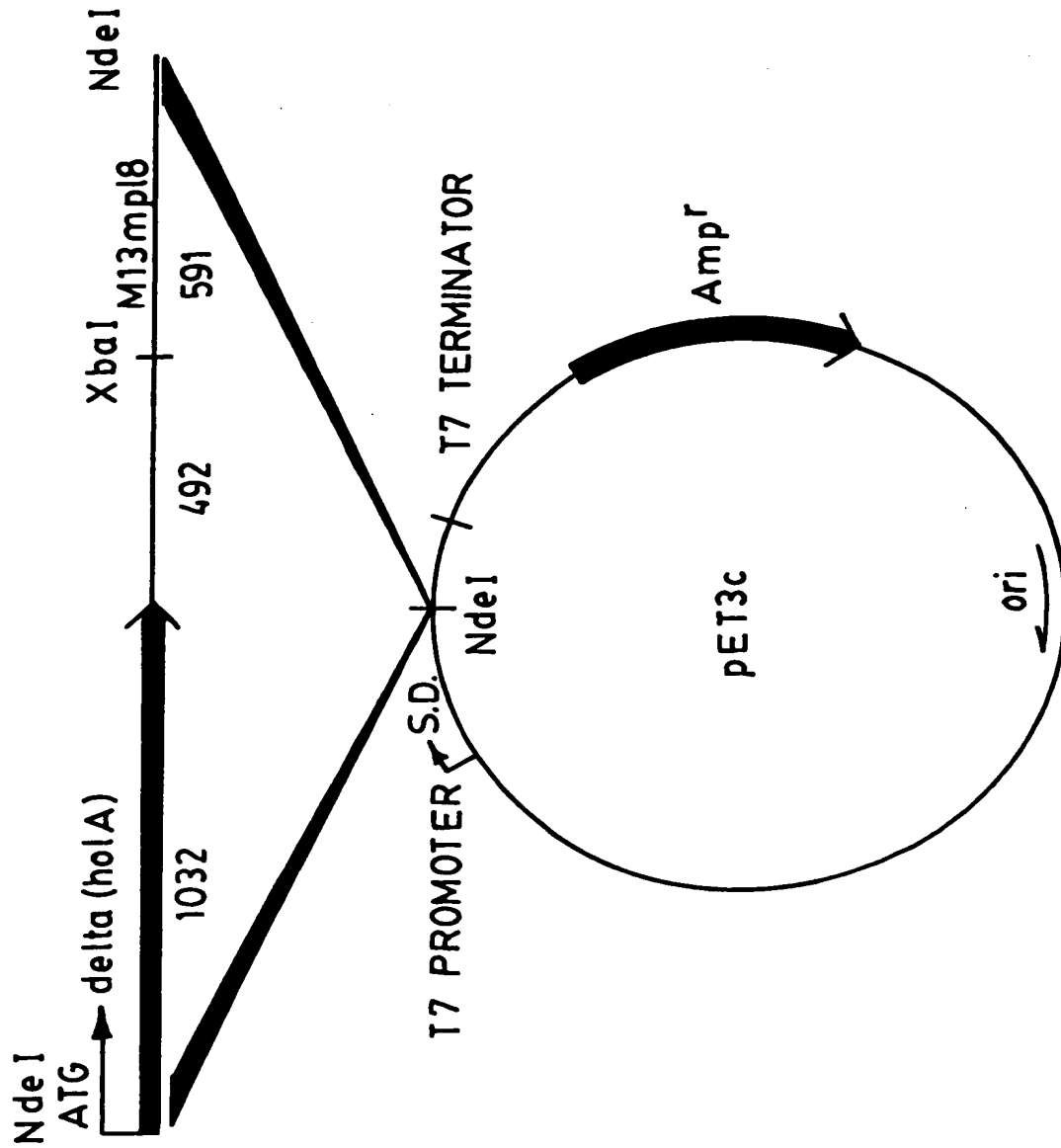
Respectfully submitted,

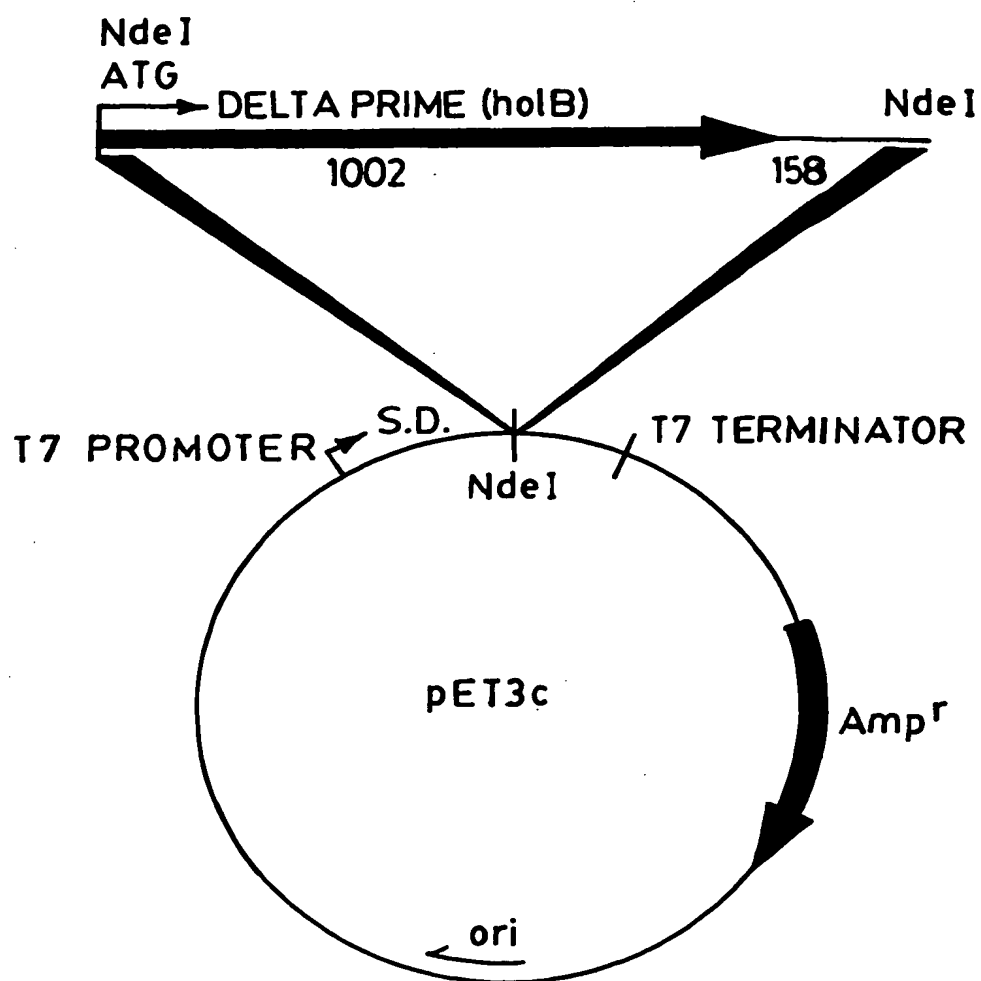
Date: January 7, 2003

  
Michael L. Goldman  
Registration No. 30,727

NIXON PEABODY LLP  
Clinton Square, P.O. Box 31051  
Rochester, New York 14603-1051  
Telephone: (585) 263-1304  
Facsimile: (585) 263-1600

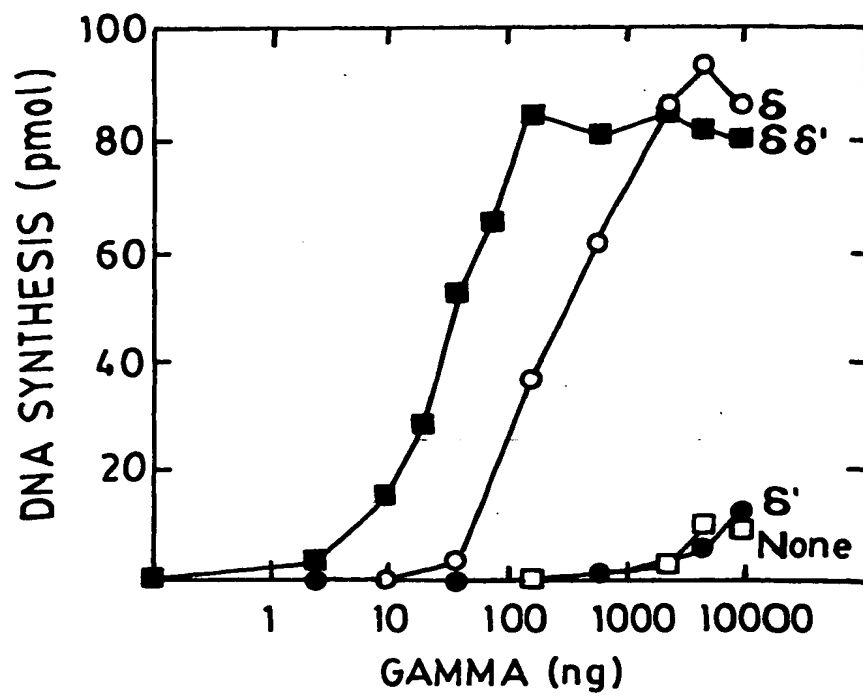
|  |                                       |
|--|---------------------------------------|
| <b>Certificate of Mailing - 37 CFR 1.8(a)</b>  |                                       |
| I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:<br>U.S. Patent and Trademark Office P.O. BOX 2327<br>Arlington, VA 22202, on the date below. <i>Box: Issue Fee</i> |                                       |
| Date <u>1/7/03</u>   | <i>Janice Bowers</i><br>Janice Bowers |

**FIG. 1**

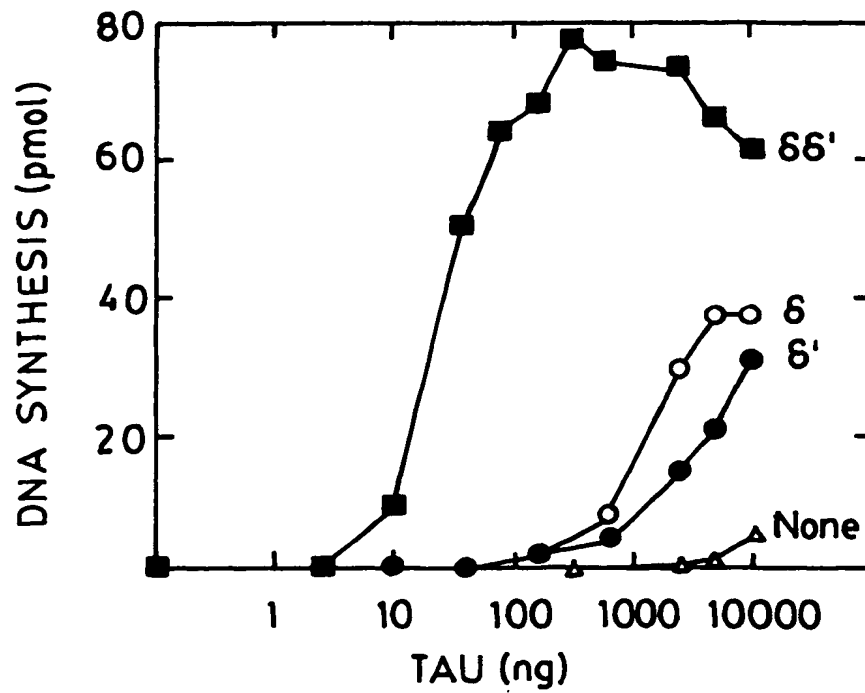


**FIG. 2**

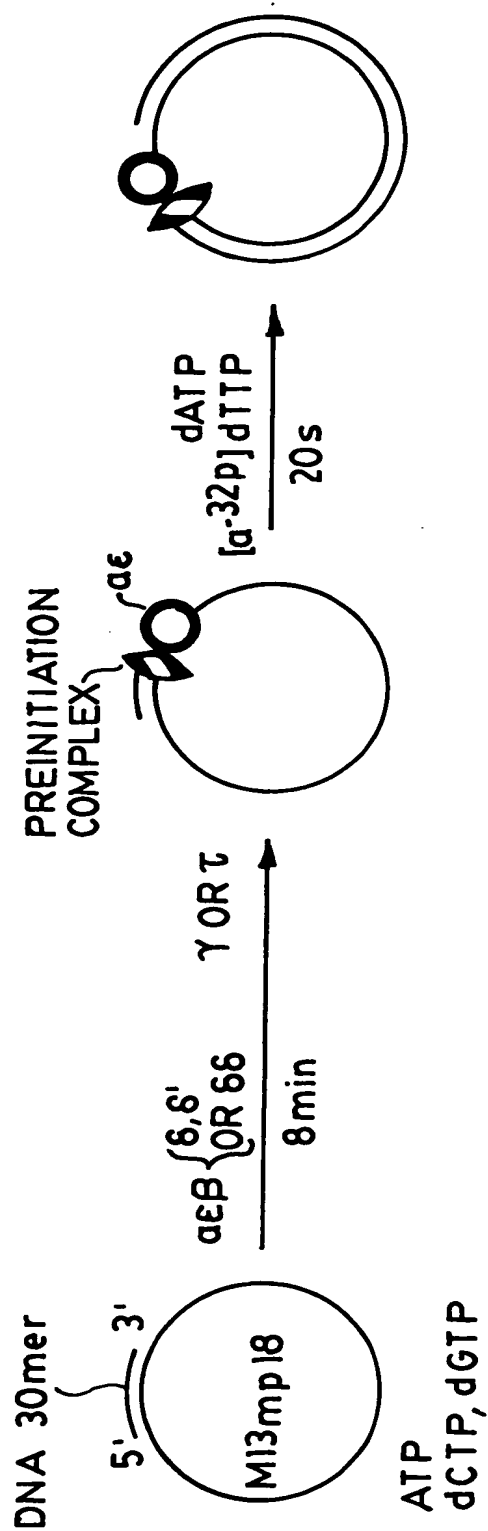
3/13



**FIG. 3A**



**FIG 3R**

**FIG. 3C**

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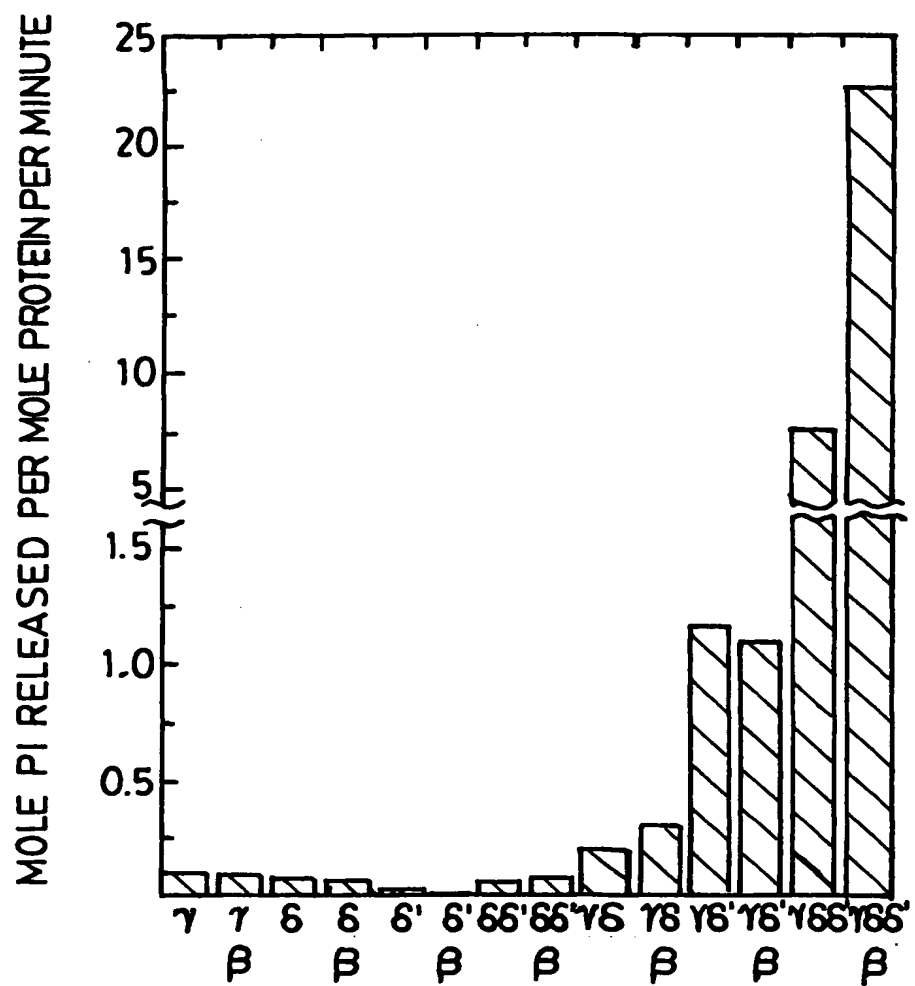


FIG. 4A

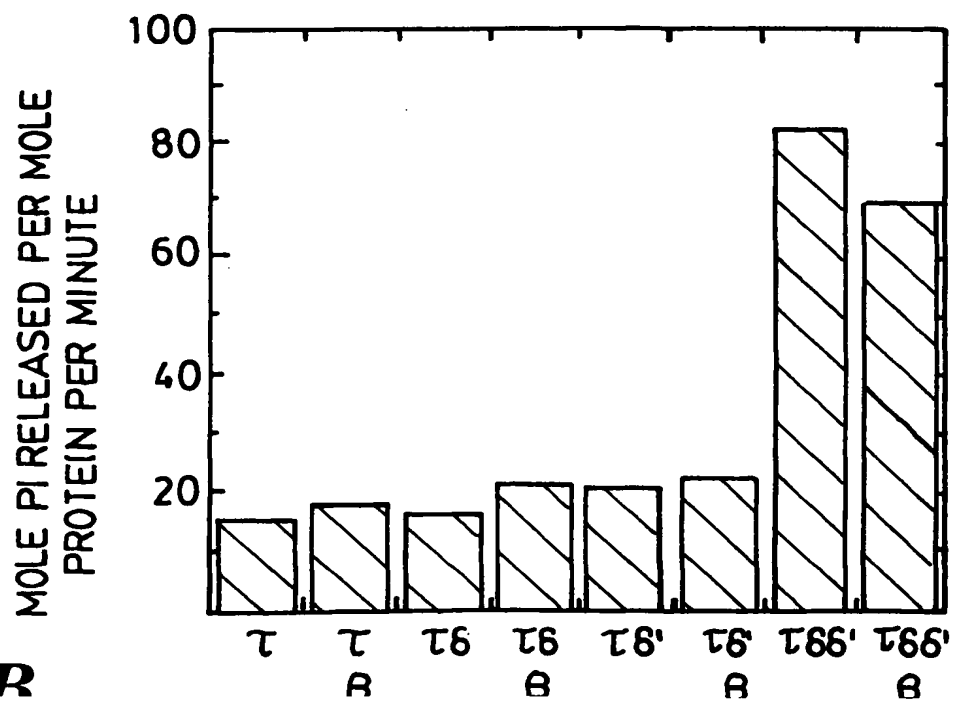
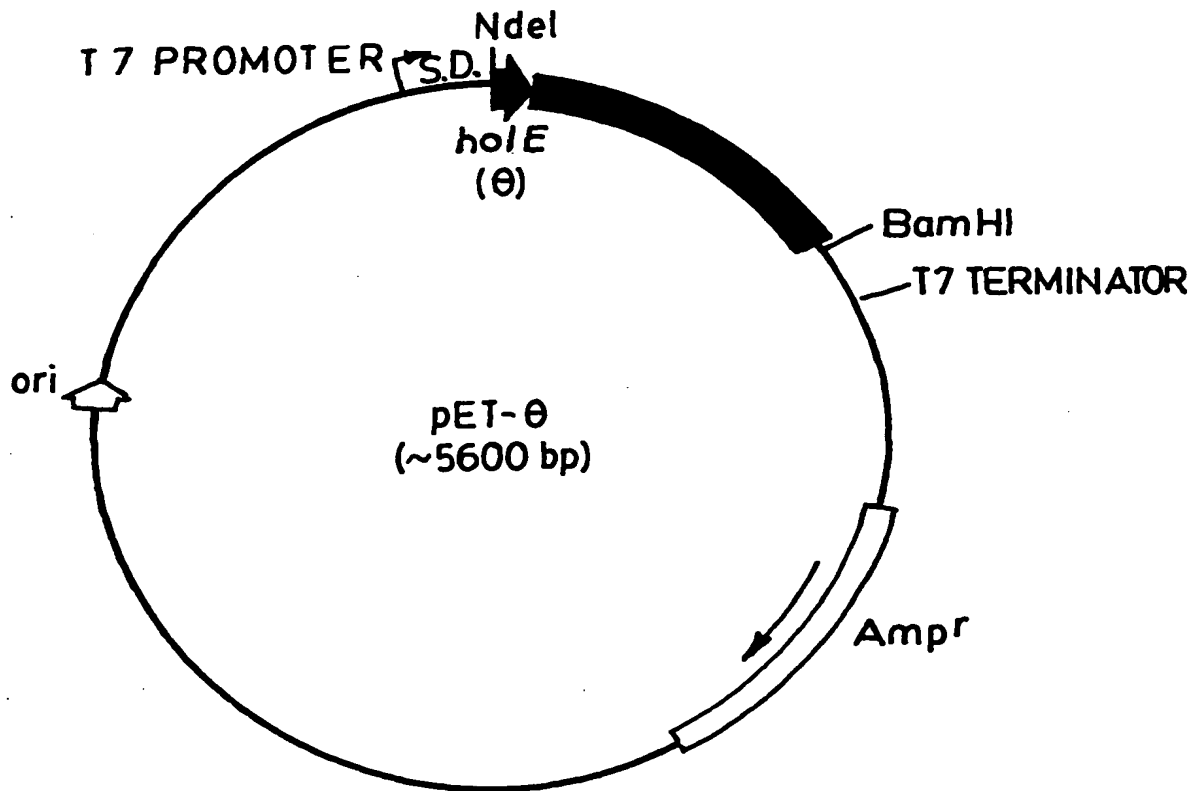
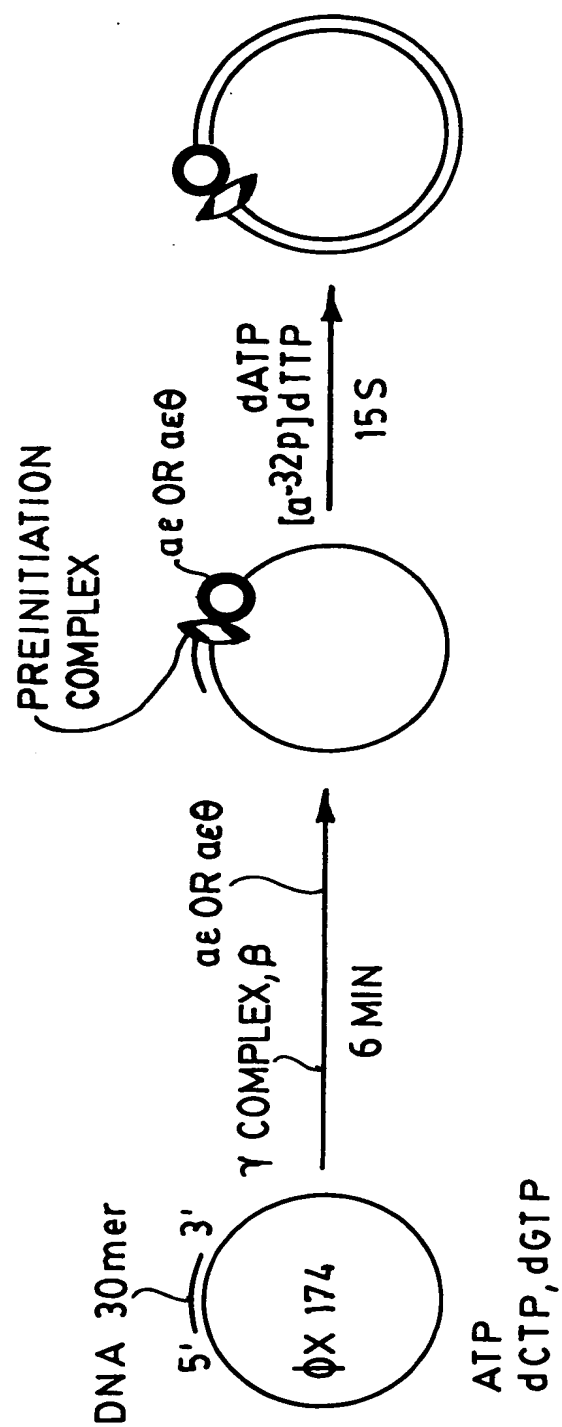


FIG 4B

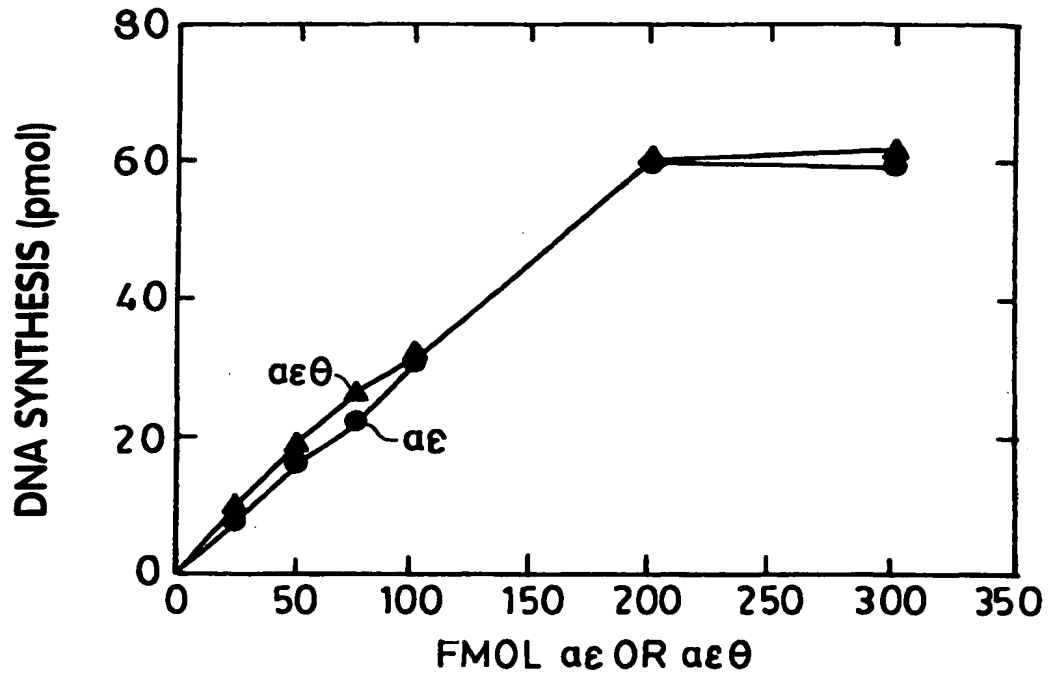


**FIG. 5**

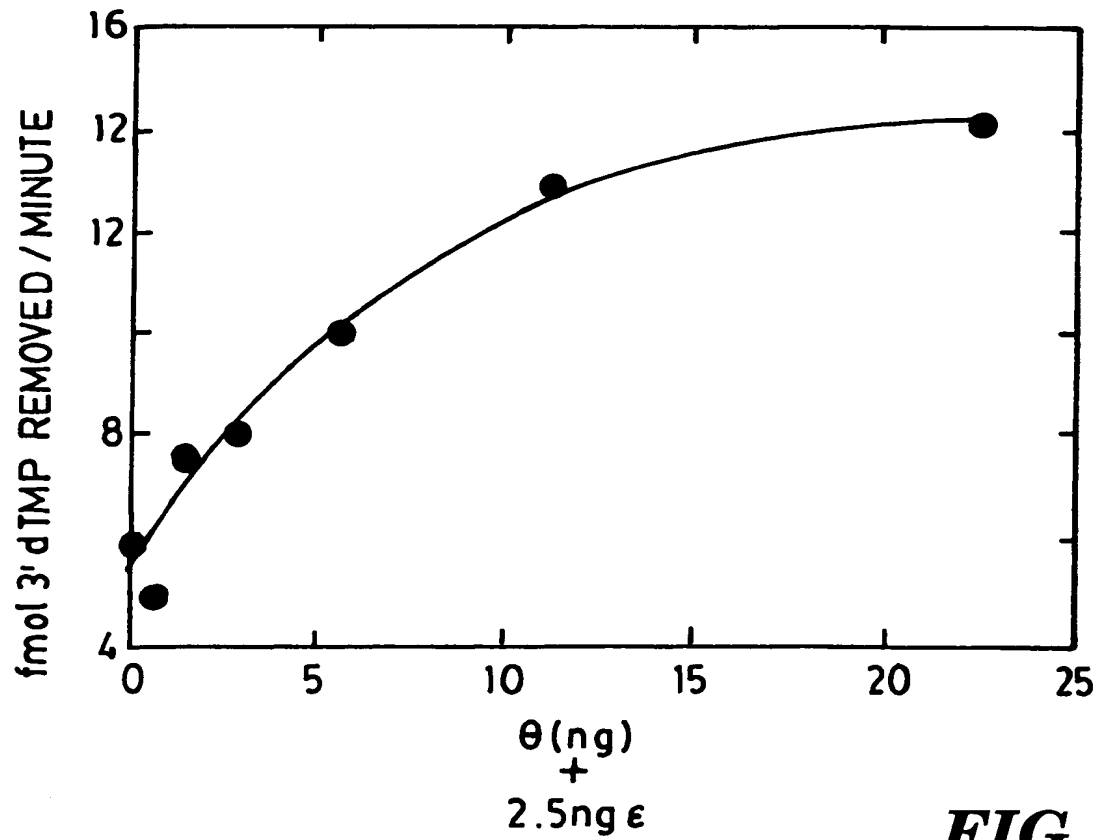
**FIG. 6A**



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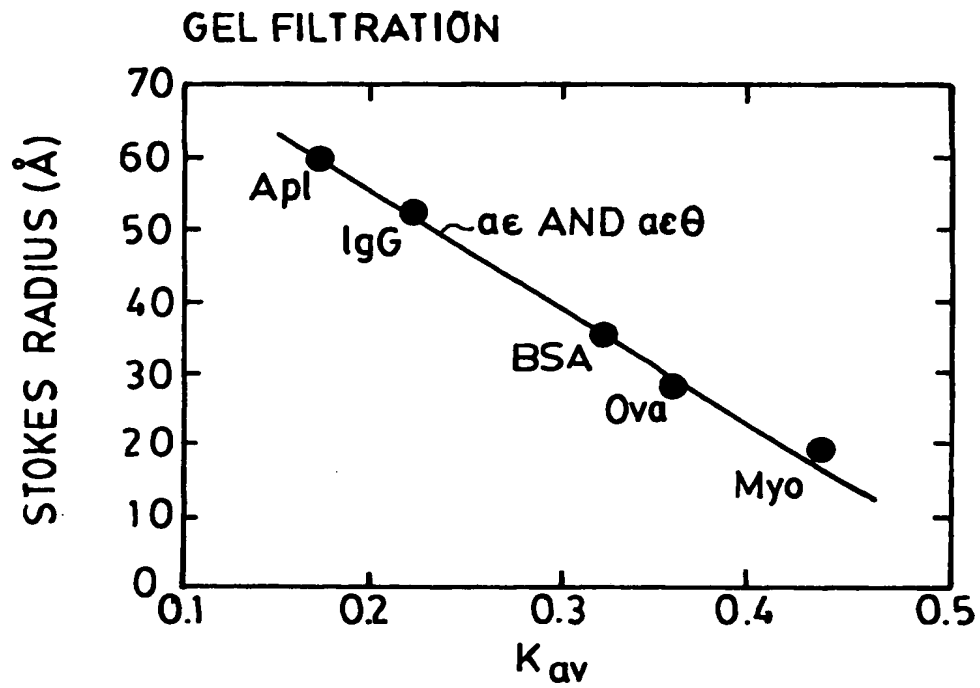


**FIG. 6B**

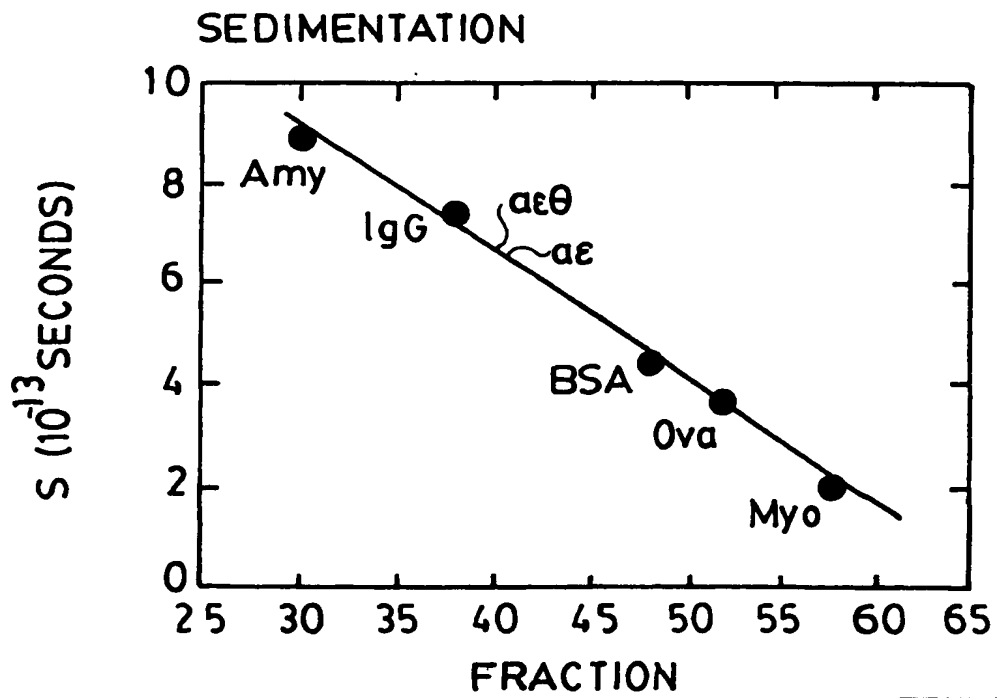


**FIG. 7**

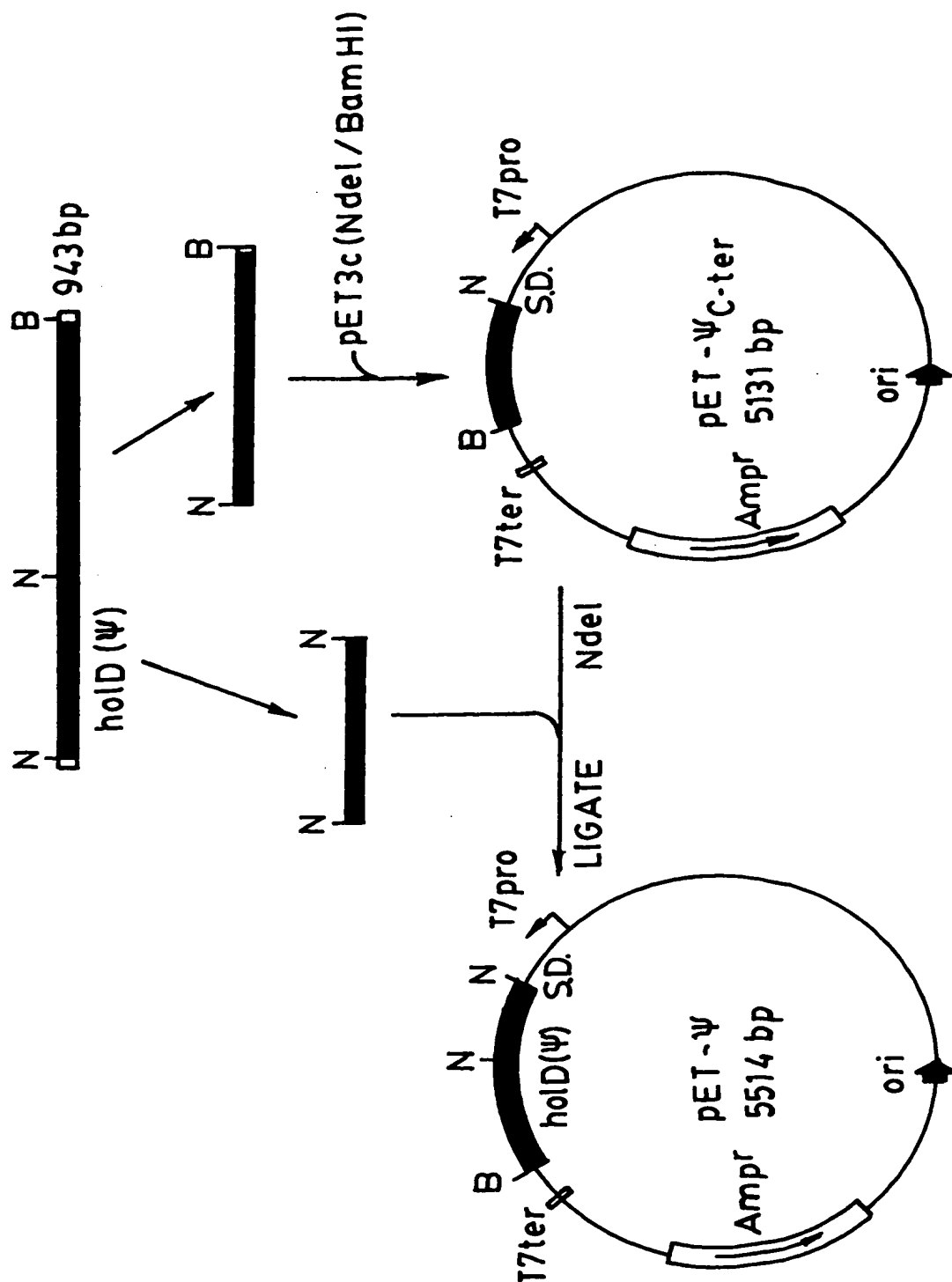
9/13



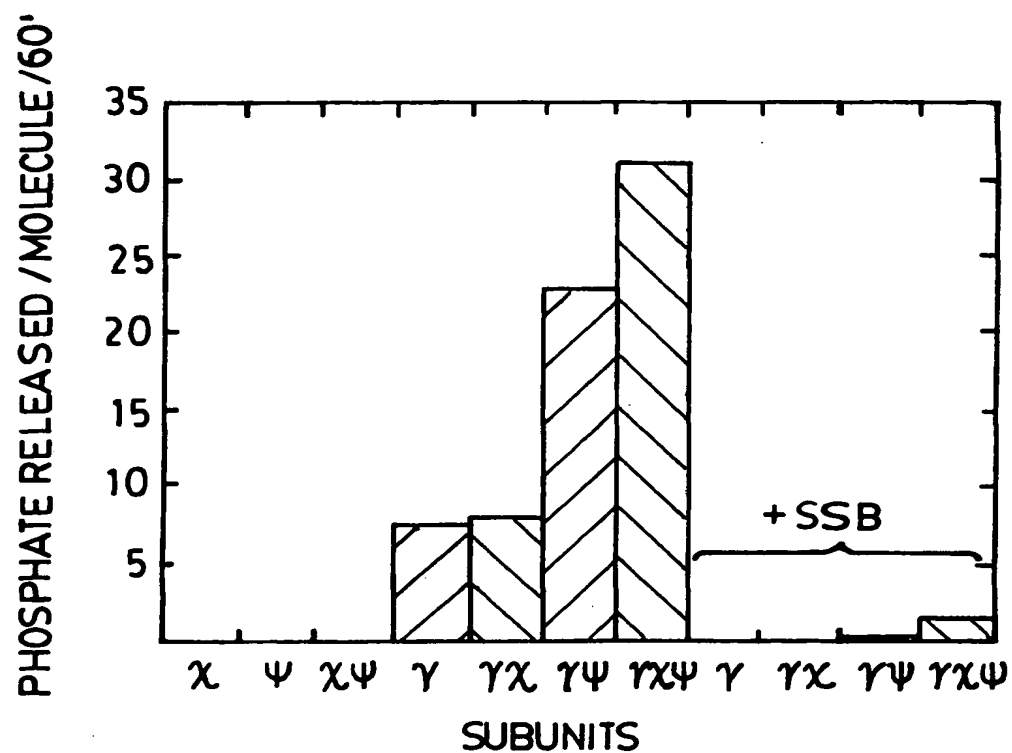
**FIG. 8A**



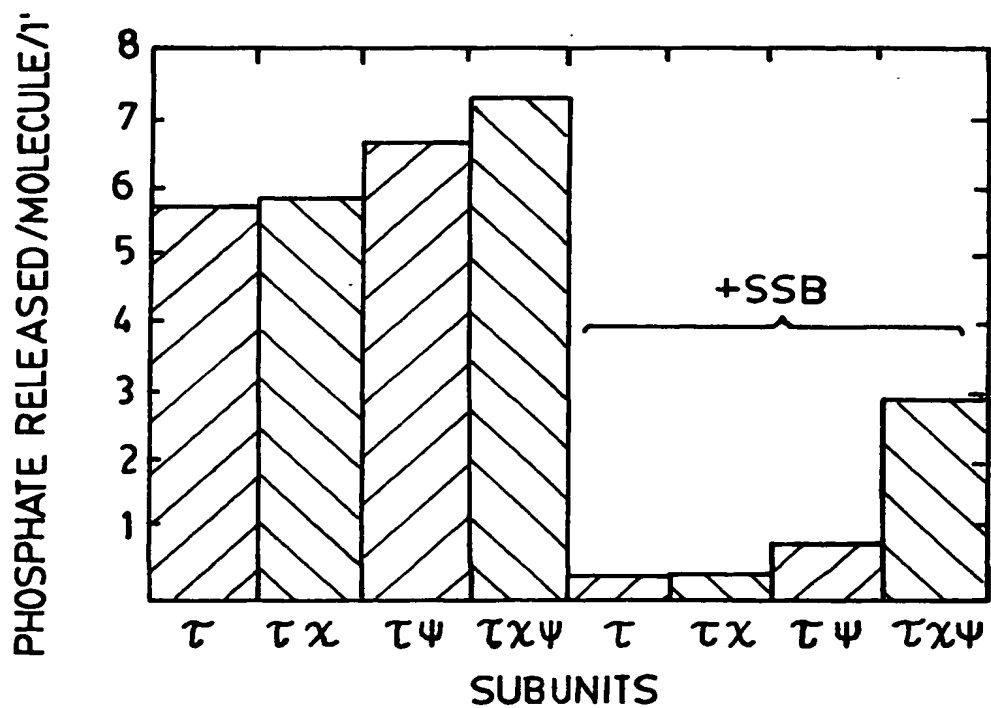
**FIG. 8B**

**FIG. 9**

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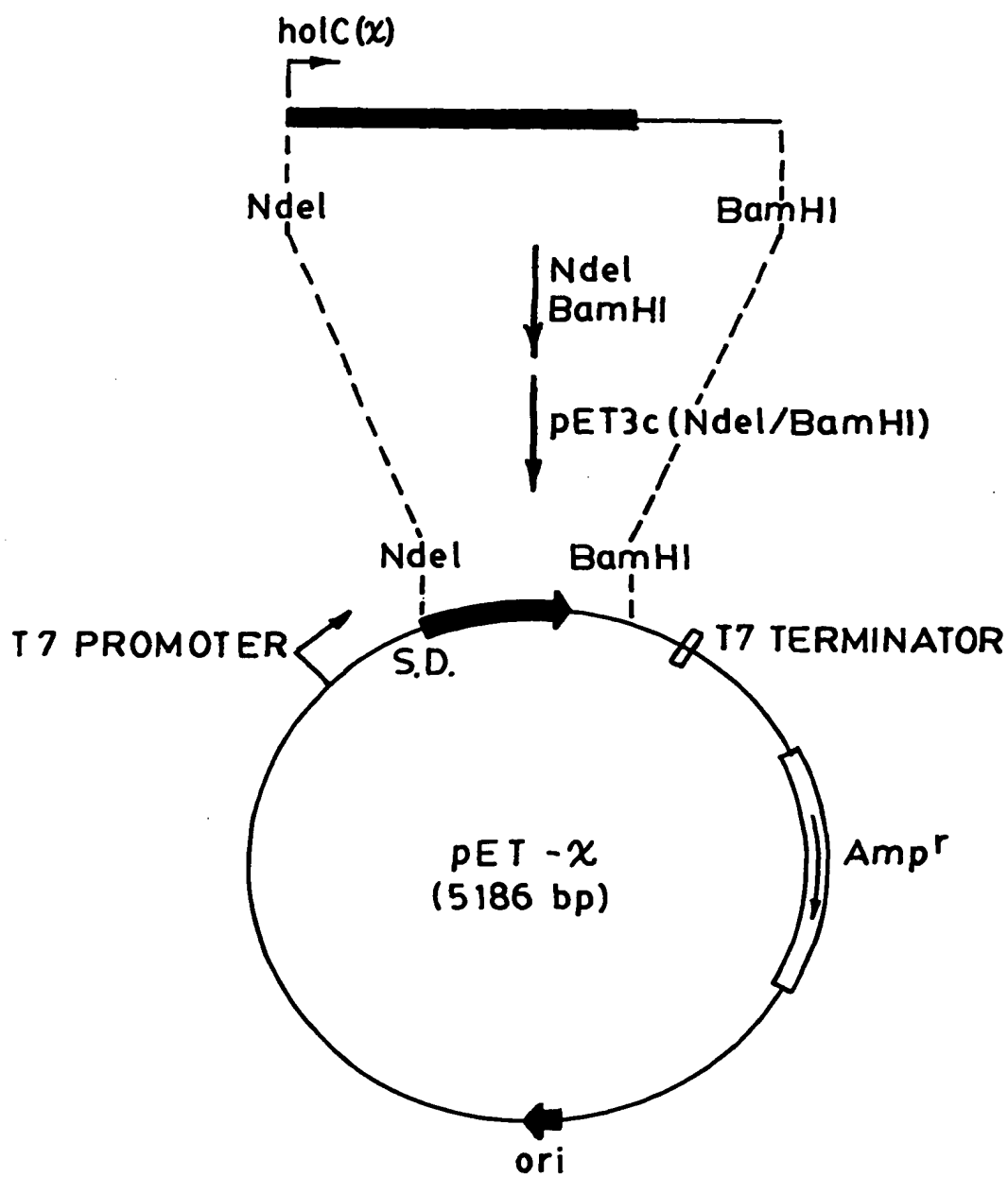


**FIG. 10A**



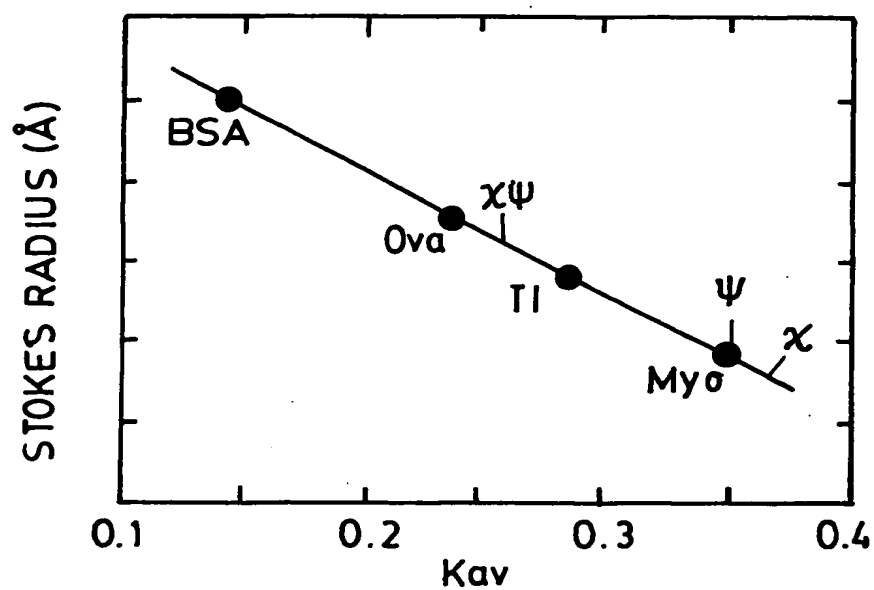
**FIG. 10B**

12/13

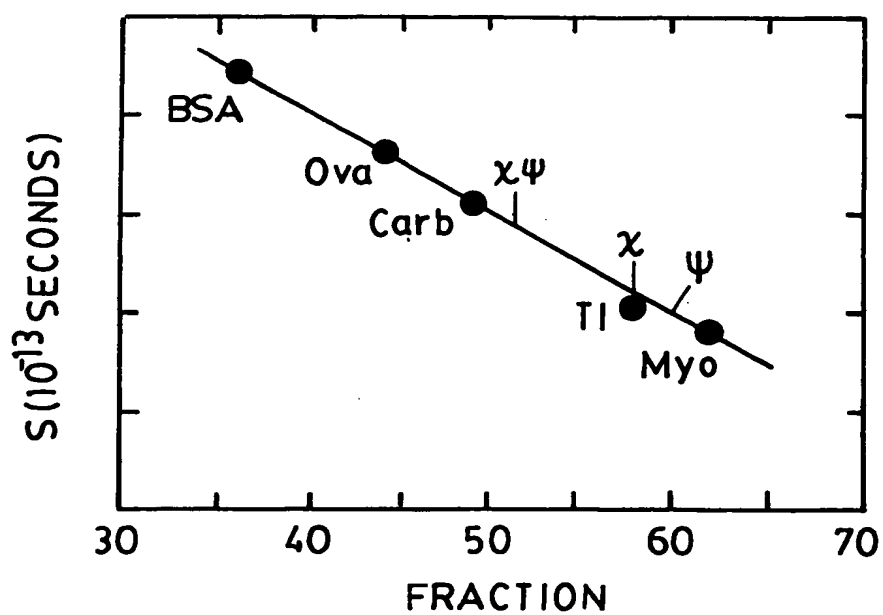


**FIG. 11**

## GEL FILTRATION

**FIG. 12A**

## SEDIMENTATION

**FIG. 12B**

UTILITY/DESIGN PATENT (1 misc)

Date:

1/7/03

Rec'd in the U.S. Patent & Trademark Office on the date stamped hereon  
via Certificate of Mail:

Case # 19603/10215 S/N: 08/828,323 Filed: 3/28/97

Pat. # \_\_\_\_\_ Issued: \_\_\_\_\_

Examiner: R. G. Hutson Art Unit: \_\_\_\_\_

Batch: \_\_\_\_\_ Atty: MLG

Applicant: Michael E. O'Donnell

For: DNA Polymerase III Helicenzyme

VERIFIED BY: Asst: \_\_\_\_\_ Quality Control: JB

☐ Appeal Brief in \_\_\_\_\_ pgs. in Triplicate

☐ \$ \_\_\_\_\_ Check for Appeal

☐ \$ \_\_\_\_\_ Check for Oral Hearing

☒ 13 pgs. Formal Drawings w/ Submission Rec.

☒ Issue Fee PTOL-85b in duplicate

☐ \$ \_\_\_\_\_ Check for Issue Fee & 10 patent copies

☐ Maintenance Fee Transmittal in Duplicate

☐ \$ \_\_\_\_\_ Check for Maintenance Fee

☐ \_\_\_\_\_

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JAN 13 2003

Nixon Peabody LLP

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FILE 19603/10215  
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**Bowers, Janice**

19603/10215

**From:** Lyon, Darlene [Darlene.Lyon@USPTO.GOV]  
**Sent:** Friday, June 13, 2003 4:59 PM  
**To:** Bowers, Janice; Lyon, Darlene  
**Subject:** RE: Status of 08/828,323

This file was abandoned for failure to perfect the drawings. It was abandoned on 2/13/03. You must Petition to revive and pay the petition fee and the issue. Petition Branch phone number is 703-305-9282.

Thank you,  
PUBS Customer Service

Darlene A. Lyon  
(703) 305-8495

-----Original Message-----

**From:** JBowers@nixonpeabody.com [mailto:JBowers@nixonpeabody.com]  
**Sent:** Thursday, June 12, 2003 3:10 PM  
**To:** Darlene.Lyon@uspto.gov  
**Subject:** RE: Status of 08/828,323

Michael L. Goldman, Registration No. 30,727.

Jan Bowers  
Paralegal  
(585) 263-1211

-----Original Message-----

**From:** Darlene.Lyon@USPTO.GOV [mailto:Darlene.Lyon@USPTO.GOV]  
**Sent:** Thursday, June 12, 2003 2:50 PM  
**To:** Bowers, Janice; PUBScustomerservice@USPTO.GOV  
**Subject:** RE: Status of 08/828,323

Please give me you Attorney registration number.

Thank you,  
PUBS Customer Service

Darlene A. Lyon  
(703) 305-8495

-----Original Message-----

**From:** JBowers@nixonpeabody.com [mailto:JBowers@nixonpeabody.com]  
**Sent:** Thursday, June 12, 2003 2:15 PM  
**To:** Pubscustomerservice@uspto.gov  
**Subject:** Status of 08/828,323

U.S. Serial No. 08/828,323, filed March 28, 1997  
Notice of Allowance mailed 10/7/2002  
Issue Fee w/ corrected corrected formal drawings mailed 1/7/03 (return receipt postcard OIPE stamped 1/10/03 and received 1/13/03)



We haven't received the issue notification for the above-identified case. Is there a date scheduled? Thank you.

Janice Bowers  
Paralegal  
Nixon Peabody LLP  
Clinton Square  
P.O. Box 31051  
Rochester, New York 14603-1051  
Telephone: (585) 263-1211  
Fax: (585) 263-1600  
E-mail: jbw@nixonpeabody.com



**UNITED STATES DEPARTMENT OF COMMERCE**  
**Patent and Trademark Office**  
ASSISTANT SECRETARY AND COMMISSIONER  
OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

**facsimile transmittal**

To: Georgia Evans

Fax: 585 263-1600

From: E. Shirenc Willis

Date: 7/16/03

Re: Notice of Abandonment in 08/828,323 Pages: 2

CC:

☐ Urgent

☒ For Review

☐ Please Comment

☐ Please Reply

☐ Please Recycle

If you have not received all pages or you have any questions about this transmission, please

contact the OFFICE OF PETITIONS AS FOLLOWS:

DIRECT TELEPHONE No.: 703-308-6712 FACSIMILE No.: 703-308-6916

NOTES: PURSUANT TO OUR TELEPHONE CONVERSATION OF 7/15/03, HERE IS THE NOTICE OF

ABANDONMENT, MAILED FEBRUARY 13, 2003.

**CONFIDENTIAL**



## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20531  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 08/828,323      | 03/28/1997  | MICHAEL E. O'DONNELL | 19603/10213         | 4760             |

7590

02/13/2003

MICHAEL L. GOLDMAN  
NIXON PEABODY LLP  
CLINTON SQUARE  
P O BOX 1051  
ROCHESTER, NY 14603

EXAMINER

HUTSON, RICHARD G

ART UNIT

PAPER NUMBER

1652

DATE MAILED: 02/13/2003

PH#38

Please find below and/or attached an Office communication concerning this application or proceeding.



**UNITED STATES DEPARTMENT OF COMMERCE**  
**Patent and Trademark Office**  
 Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
 Washington, D.C. 20231

|                    |             |                       |                     |
|--------------------|-------------|-----------------------|---------------------|
| APPLICATION NUMBER | FILING DATE | FIRST NAMED APPLICANT | ATTORNEY DOCKET NO. |
|--------------------|-------------|-----------------------|---------------------|

08/28, 323

|          |
|----------|
| EXAMINER |
|----------|

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

P#38

DATE MAILED:

**NOTICE OF ABANDONMENT**

This application is abandoned in view of:

- ☐ Applicant's failure to timely file a proper response to the Office letter mailed on \_\_\_\_\_.
- ☐ A response (with a Certificate of Mailing or Transmission of \_\_\_\_\_) was received on \_\_\_\_\_, which is after the expiration of the period for response (including a total extension of time of \_\_\_\_\_ month(s)) which expired on \_\_\_\_\_.
- ☐ A proposed response was received on \_\_\_\_\_, but it does not constitute a proper response to the final rejection.
- (A proper response to a final rejection consists only of: a timely filed amendment which places the application in condition for allowance; a Notice of Appeal; or the filing of a continuing application under 37 CFR 1.62 (FWC).)
- ☐ No response has been received.

☒ Applicant's failure to timely pay the required issue fee within the statutory period of three months from the mailing date of the Notice of Allowance.

- ☐ The issue fee (with a Certificate of Mailing or Transmission of \_\_\_\_\_) was received on \_\_\_\_\_.
- ☐ The submitted issue fee of \$\_\_\_\_\_ is insufficient. The issue fee required by 37 CFR 1.18 is \$\_\_\_\_\_.
- ☒ The issue fee has not been received.
- ☐ Applicant's failure to timely file new formal drawings as required in the Notice of Allowability.
- ☐ Proposed new formal drawings (with a Certificate of Mailing or Transmission of \_\_\_\_\_) were received on \_\_\_\_\_.
- ☐ The proposed new formal drawings filed \_\_\_\_\_ are not acceptable.
- ☐ No proposed new formal drawings have been received.
- ☐ The express abandonment under 37 CFR 1.62(g) in favor of the FWC application filed on \_\_\_\_\_.
- ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
- ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a) upon the filing of a continuing application.
- ☐ The decision by the Board of Patent Appeals and Interferences rendered on \_\_\_\_\_ and because the period for seeking court review of the decision has expired and there are no allowed claims.
- ☐ The reason(s) below:

**ABANDONMENT**  
**CONTACT PERSON IS:**  
**TOM HAWKINS**  
**305-6380**

\*\*\*\*\*  
Case History For Docket Number: 19603/10215 Country: USA  
\*\*\*\*\*

Report Run Date:23JL2003

Application Number: 08/828,323  
Application Date: 28MR1997  
Patent Number:  
Grant Date:  
Client/Division: CORNELL MEDICAL COLLEGE  
Attorney: MLG  
Current Owner: CORNELL RESEARCH FOUNDATION  
Inventors: MICHAEL O'DONNELL  
Title: DNA POLYMERASE III HOLOENZYME  
\*\*\*\*\*

|  |                          |             |                    |
|--|--------------------------|-------------|--------------------|
| Action: IDS NOT APPLICABLE               | Completed Date:          | Taken Date: | Due Date:          |
| Action: ISSUE NOTIFICATION OF PATENT     | Completed Date:          | Taken Date: | Due Date: 07AP2003 |
| Action: LARGE ENTITY STATUS              | Completed Date:          | Taken Date: | Due Date:          |
| Action: CONTINUING PROSECUTION FILED     | Completed Date: 20SE2000 | Taken Date: | Due Date:          |
| Action: POSTCARD REMINDER                | Completed Date: 26SE2000 | Taken Date: | Due Date: 20OC2000 |
| Action: PRELIMINARY AMENDMENT FILED      | Completed Date: 15NO2000 | Taken Date: | Due Date:          |
| Action: NOTICE FROM PTO                  | Completed Date: 18JA2001 | Taken Date: | Due Date:          |
| Action: OFFICE ACTION FROM PTO           | Completed Date: 08FE2001 | Taken Date: | Due Date:          |
| Action: 3 MONTH EXT. OF TIME             | Completed Date: 08AU2001 | Taken Date: | Due Date:          |
| Action: AMENDMENT DUE                    | Completed Date: 08AU2001 | Taken Date: | Due Date: 08MY2001 |
| Action: SUPPLEMENTAL AMENDMENT TO PTO    | Completed Date: 02NO2001 | Taken Date: | Due Date:          |
| Action: NOTICE FROM PTO                  | Completed Date: 31DE2001 | Taken Date: | Due Date:          |
| Action: NOTICE OF ALLOWANCE FROM PTO     | Completed Date: 31DE2001 | Taken Date: | Due Date:          |
| Action: FORMAL DRAWINGS DUE              | Completed Date: 28MR2002 | Taken Date: | Due Date: 31MR2002 |
| Action: ISSUE FEE DUE                    | Completed Date: 28MR2002 | Taken Date: | Due Date: 31MR2002 |
| Action: PETITION TO PTO                  | Completed Date: 25JE2002 | Taken Date: | Due Date:          |
| Action: INFORMATION DISCLOSURE STATEMENT | Completed Date: 25JE2002 | Taken Date: | Due Date: 28JE2002 |
| Action: ISSUE NOTIFICATION OF PATENT     | Completed Date: 25JE2002 | Taken Date: | Due Date:          |
| Action: WITHDRAWN FROM ISSUE             | Completed Date: 25JE2002 | Taken Date: | Due Date:          |
| Action: REQUEST FOR CONT. EXAM FILED     | Completed Date: 25JE2002 | Taken Date: | Due Date:          |
| Action: PETITION GRANTED                 | Completed Date: 26JE2002 | Taken Date: | Due Date:          |
| Action: SUPPLEMENTAL DISCLOSURE          | Completed Date: 18JL2002 | Taken Date: | Due Date:          |
| Action: NOTICE OF ALLOWANCE FROM PTO     | Completed Date: 07OC2002 | Taken Date: | Due Date:          |
| Action: ISSUE FEE DUE                    | Completed Date: 07JA2003 | Taken Date: | Due Date: 07JA2003 |
| Action: FORMAL DRAWINGS DUE              | Completed Date: 07JA2003 | Taken Date: | Due Date: 07JA2003 |

19603/10215

(CRF'D-11560)

\*CFM  
19603/10215

CLIENT or TITLE  
DIVISION OF CPA of 08/03/97  
CONTINUATION NUMBER OF 08/27/97

INVENTOR  
Michael E. O'Donnell

SERIAL NO.

(CRF'D-11560)

INVENTOR Michael E. O'Donnell

SERIAL NO. 08/828,323

FILED Mar 25, 1997

TITLE DNA Polymerase III Holoenzyme

ASSIGNEE Cornell

ASSIGNMENT RECORDED 7/21/1995

REEL 7560

FRAME 0937

OFFICE ACTIONS

AMENDMENTS

8/2001 AMENDMENT DUE  
MAY 8, 2001  
13/02 ISSUE FEE/FORMAL DRAWINGS  
MARCH 31, 2002

CPA PA to PTO-ELM-9/20/2000.  
Prelim. Amend. to PTO-FCM-  
11/15/2000.  
Amend. w/ 3-mo EXT to PTO-  
FCM- 8/18/2001  
Suppl. Amendment to PTO- via FAX-  
11/2/2001  
ISSUE FEE W/ FORMAL DRAWINGS TO  
PTO-FCM- 3/28/02  
PTN TO WITHDRAW APPN FROM ISSUE, to  
PTO- via FAX- 6/25/02

RCE

10/26/02 PETITION GRANTED  
10/7/02 ISSUE FEE/FORMAL DRAWINGS  
JANUARY 7, 2003

REQT. for Cont. Exam., IDS to  
PTO- via FAX- 6/25/02  
Suppl. IDS to PTO- via Hand Delivery-  
7/18/02  
ISSUE FEE/FORMAL drawings to  
PTO-FCM- 1/7/2003

\*Large Entity

LOWED

FINAL FEE PAID

TENT NO.

DATE

Kruysman  
Long Island City, NY 11101 (718) 433-3800 (800) 221-3218  
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MLG/GCE

ENTERED  
Nixon Peabody LLP

SEP 21 2000

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19603/10215  
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OTHER FOREIGN

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